

REMARKS

In the Office Action, the Examiner rejected claims 1-25 and withdrew claims 26-67 from consideration. By the present Response, Applicant amends claim 1, 7, and 10 to further clarify the claimed subject matter, cancels claims 9 and 26-67, and adds new claims 68-110. Upon entry of the amendments, claims 1-8, 10-25, and 68-110 will be pending in the present patent application. Applicant respectfully requests reconsideration of the above-referenced application in view of the following remarks.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-8 and 10-25 under 35 U.S.C. § 103(a) as unpatentable over Eder (U.S. Patent No. 6,321,205) in view of Hosios et al. Applicant respectfully traverses this rejection.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Omitted Features of Independent Claim 1

Applicant respectfully notes that the Eder and Hosios et al. references fail to disclose each element of independent claim 1. For instance, independent claim 1 recites “financial data including *an internal discount rate set by the client* for evaluating

investment acceptability” (emphasis added). Because the cited references fail to disclose such an element, the cited references cannot support a *prima facie* case of obviousness with respect to independent claim 1.

The Eder reference is generally directed to a system for business simulation and analysis. Col. 7, line 66 – col. 8, line 1. To this end, Eder discloses application software 200, 300, *et seq.*, to complete the calculations required to calculate a detailed business evaluation. Col. 9, lines 41-44. Particularly, portion 200 of the application software extracts, aggregates, and stores the information required for system operation. Col. 12, lines 32-40. Notably, such information may include information on growth options, taxes, equity, liabilities, or the like. Col. 21, line 65 – col. 22, line 50; FIG. 5B. This information, in turn, may be used to calculate a current weighted average cost of capital (WACC) for the business. Col. 22, line 66 – col. 23, line 10.

In the Office Action, the Examiner relied upon the Eder reference as disclosing an “internal discount rate set by the client for evaluating investment acceptability” as recited by independent claim 1. *See* Office Action mailed May 5, 2005, page 5. Particularly, the Examiner suggested that the weighted average cost of capital discussed in the Eder reference is equivalent to the internal discount rate recited by the instant claims. *See* col. 22, line 65 – col. 23, line 20. However, Applicant respectfully submits that this weighted average cost of capital is not equivalent to the recited internal discount rate.

As will be appreciated by one skilled in the art, the weighted average cost of capital for a company is the average cost associated with various funding mechanisms, such as equities (i.e., stocks) and traditional debt. Generally speaking, this weighted average cost of capital represents the amount of interest a company would have to pay for every dollar of capital gained through a stock offering or loan. However, the passage of the Eder reference cited by the Examiner fails to teach any correlation between the weighted average cost of capital calculation taught by the reference and the recited

internal discount set by the client. As may also be appreciated, the recited internal discount rate is an adjustment to the rate of return, set by the client, of a potential investment. This discount rate can be based on any number of factors including, but not limited to, inflation, expected market changes, and expected returns on alternative investments, present or future.

Because these terms have two different meanings, Applicant respectfully submits the weighted average cost of capital of the Eder reference cannot be reasonably equated with the “internal discount rate set by the client for evaluating investment acceptability” as recited in independent claim 1. Consequently, the Eder reference, taken alone or in hypothetical combination with the Hosios et al. reference, fails to disclose each and every element of the instant claim and, therefore, cannot support a *prima facie* case of obviousness with respect to independent claim 1. However, should the Examiner maintain his belief that these two terms are equivalent, Applicant respectfully requests that the Examiner provide a rational basis for such an assertion.

Omitted Features of the Dependent Claims

The Eder and Hosios et al. references also fail to teach or suggest all of the subject matter recited in the dependent claims. For instance, dependent claim 7 recites “receiving client-defined potential financing terms for the desired capital investment.” In the Office Action, the Examiner argued that the Eder reference discloses this element. *See* Office Action mailed May 5, 2005, page 5; Eder, col. 22, lines 20-50. However, Applicant respectfully submits that the cited passage merely describes entry of information related to liabilities and equities, such as stocks and dividends. While it may disclose general liabilities and the annual interest owed on these liabilities, it does not disclose *potential* financing terms *for a particular investment* under consideration. Consequently, Applicant respectfully submits that the Eder reference cannot be fairly considered to disclose “receiving client-defined potential financing terms for the desired capital investment.”

Moreover, the Hosios et al. reference does not obviate the deficiencies of the Eder et al. reference.

Additionally, dependent claims 10-14 also recite subject matter absent from the cited references. In the Office Action, the Examiner relied upon the Hosios et al. reference as disclosing the subject matter recited in dependent claims 10-14. Notably, the Examiner merely referred to pages 210-214 of the reference, and generally indicated that the subject matter recited in claims 10-14 was disclosed by this passage. As will be appreciated, the Hosios et al. reference is directed to a decision-making aid for medical resource allocation. *See* Hosios et al., page 205. Particularly, Hosios et al. teach a linear programming production model of a diagnostic radiology department. *Id.* While the Hosios et al. reference addresses medical resource allocation, the passage relied upon by the Examiner fails to disclose, teach, or even suggest the subject matter recited by claims 10-14.

For instance, dependent claim 10 recites “receiving from the client medical procedures statistics expected to be changed by implementing the desired capital investment.” The Hosios et al. reference fails to mention a client inputting medical procedure statistics expected to change via implementation of a particular capital investment. Further, dependent claims 11 and 12 generally recite receiving projected statistics for new and lost medical procedures, respectively, resulting from implementation of a desired capital investment. Still further, dependent claims 13 and 14 respectively recite receiving a projected mix of payor types for medical procedure and receiving the projected mix for inpatients and outpatients at a medical facility. Upon analysis, Applicant could find no such teachings in the passage cited by the Examiner or in the Hosios et al. reference as a whole. As such, the Hosios et al. reference apparently fails to disclose the subject matter of dependent claims 10-14. Furthermore, the Eder reference fails obviate the deficiencies of the Hosios et al. reference. As a result,

dependent claims 10-14 are believed to recite subject matter that is allowable over the art of record.

For these reasons, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 103 and allowance of claims 1-8 and 10-25.

New Claims

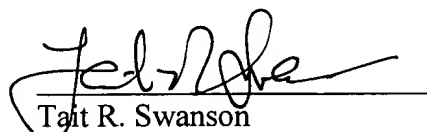
New claims 68-110 have been added by this Response. These new claims add no new matter and are fully supported throughout the specification. Further, these new claims are believed to read on the species elected by Applicant in the Response filed December 17, 2004. For various reasons, including those provided above with respect to independent claim 1 and dependent claims 7 and 10, claims 68-110 are patentable over the cited references and are believed to be in condition for allowance. Accordingly, Applicant respectfully requests allowance of claims 68-110.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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